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09/734,988	12/11/2000	David Resnick	39048.21	6113

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EXAMINER	
MILEF, ELDA G	
ART UNIT	PAPER NUMBER
3692	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/734,988	RESNICK ET AL.	
	Examiner	Art Unit	
	Elda Milef	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-65* is/are pending in the application.

4a) Of the above claim(s) *1-34,50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-49 and 51-65* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 35,36,38-42,48,49,52,53,57-61,63, 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorf (U.S. Patent No. 6,000,608).

Re claim 35: Dorf discloses:

a terminal located at a point-of-sale where monetary consideration is received from or on behalf of an end-user to pre-pay for selected goods or services, the terminal operable to exchange electronic messages with a financial network;

a financial network operable to exchange electronic messages with the point-of-sale terminal;

("The system 108 comprises a plurality of cards 101, a sponsor bank processor 102, and a processing hub 103, which serves as the nerve center of the system 108. If the system 108 is to provide prepaid phone cards, it will also include a prepaid phone card issuer hub 104 maintained by a prepaid phone card issuer. In order to achieve the desired functionality, the system 108 uses existing banking networks in a unique and novel way to gain access to virtually all existing retail point-of-sale (POS) devices 105. These devices 105 include stand-alone POS terminals, cash registers with POS interfacing, computers with POS interfacing, and other similar devices which can be used to access the banking system.")-see col. 4 lines 19-32;

a payment processor including a database for storing a list of participating point-of-sale merchants and further including a database associating each of a plurality of intermediary account numbers with at least one corresponding end-user account number, each end-user account number associated with a corresponding vendor ("Once the data is received...the processing hub 103 recognizes the identification number of the card as being associated with a particular prepaid phone card issuer. Next, a security check is

performed to verify that this transaction is originating from a retailer that is authorized to sell the prepaid phone cards. If the transaction is originating from an authorized retailer, the transaction will proceed…The issuer hub104 contains one or more phone databases204…When the issuer gub 104 receives the data from the processing hub103, it activates the record in the phone card datbase204 having the same identification as the card 101 …upon receipt of the transaction data, the hub 103 recognizes the card 101 as being an Electronic Gift Certificate card of the retail issuer and activates or recharged the card 101 In the appropriate amount in an EGC database205 maintained at the processing hub 103.")-see col. 7 line 2-col. 8 line 2;

and the payment processor operable to exchange electronic messages with the point-of-sale terminal via the financial network and including means for crediting an indicia of monetary value to a corresponding intermediary account stored in a database coupled to the payment processor in response to receiving a payment message from the point-of-sale terminal, and further including interface means for communicating at least a recharge transaction to the corresponding vendor to credit a selected one of the end-user accounts associated with the corresponding intermediary account in response to crediting the corresponding

intermediary account("Optionally, the Electronic Gift Certificate card 101 could also be recharged, the recipient of the card101 is allowed to make purchases using the card… If the card 101 is for use in many retail locations, it would instead be processed during purchase transactions as a typical debit card, preferably using the debit network107…the retail issuer or the cardholder must have an account with the sponsor bank…The sponsor bank then transfers the purchase amount…The transaction data is then forwarded to the processing hub 103 so that the EGC database 205 can be updated…-see col. 8- col.9 line 10, col. 10 lines 62-64.

-Also, see cols. 4-6, Figs. 1 and 2.

Re claim 36 & 64: Dorf discloses a system and method:

wherein the point-of-sale terminal comprises an automated teller machine (ATM)-see col. 1;

Re claims 38 and 39: Dorf discloses a wherein the financial network comprises a card association network, and the acquiring processor for communicating messages between the financial network and a plurality of such terminals.-see col. 1 lines 19-23, col. 4 lines 47-67.

Re claims 40, 41: Dorf discloses:

establishing an intermediary account having a corresponding account identifier;

associating the account identifier of the intermediary account with an end-user's prepaid account maintained by a telecommunication vendor and storing the association in a database coupled to a central payment processor, wherein the association includes information that allows the central payment processor to identify the end-user's prepaid account when presented with the account identifier;

-see col. 7 lines 2-26, and Figs. 1 and 2;

facilitating a payment transaction between the end-user and a point-of-sale, the payment transaction comprising receiving a payment from the end-user at the point-of-sale together with the account identifier for loading value into the end-user's prepaid account-see col. 7 line 35-col. 8 line 21;

electronically and directly communicating data indicative of the transaction from the point-of-sale to the central payment processor-see "processing hub"-fig.2 and related text;

in the central payment processor, validating the transaction data and transmitting a response to the point-of-sale-see col.8 lines 22-33;

and in the central payment processor, if the validating step results in approval of the transaction, sending a message to the telecommunication vendor for loading value into the end-user's associated prepaid

account responsive to the payment transaction-see col. 6 line 65-col. 7 line 27, col. 8 line 50-col.9 line 10, col. 10 lines 61-64.

Re claim 42: Dorf discloses:

wherein said communicating step comprises communication between the point-of-sale and the central payment processor via a merchant hub.-see fig.2 "Retailer E".

Re claim 48: Dorf discloses a method for effecting payment for goods and services-see cols. 7-9, further the remaining limitations are similar to those in claim 40 and are rejected using the same art and rationale.

Re claim 49: Dorf disclose issuing a card to the end-user that includes identification of the end-user's intermediary account.-see col. 7 lines 2-20.

Re claims 52, 53, 57: Dorf discloses wherein the end-user's account has an account number corresponding to a valid credit card account number and can be presented by the end-user to purchase goods and services.-see col. 4 lines 36-67 and col. 1.

Re claim 58: Dorf discloses wherein the end-user's account has an account number corresponding to a valid credit card account number to facilitate electronic messaging over existing credit card association networks.-see col. 4.

Re claims 59-61: Dorf discloses:

wherein receiving a payment from the end-user at the point of sale includes receiving the payment:

in the form of cash-see col.5;

as a debit card transaction-see cols. 5,7,8;

as a credit card transaction-see col.8 lines 3-6;

Re claim 63: Dorf discloses a brick-and-mortar retail merchant site.-see col. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 37,43,45-47,54,55,62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Muehlberger (U.S. Patent No. 5,696,908).

Re claim 37 & 62: Although Dorf discloses a system and method, ("In order to achieve the desired functionality, the system 108 uses existing banking networks in a unique and novel way to gain access to virtually all existing retail point-of-sale (POS) devices 105…")-see col. 4 lines 25-35, Dorf does not specifically disclose wherein the point-of-sale terminal comprises a vending machine. Muehlberger however, teaches ("Telephone debit cards are automatically vended through a microprocessor controlled vending machine -see Abstract, and col.3 It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include that the point-of-sale terminal be a vending machine as taught by Muehlberger in order to provide the customer with convenience of purchasing a pre-paid card at multiple locations.

Re claims 43, 45, 47, 54, 55: Dorf discloses a system and method designating an intermediary bank account and collecting an amount of money equal to the payment amount, subject to adjustment, from the point-of-sale merchant's bank account into the intermediary bank account.-see fig. 2 and col. 6 lines 32-51. Dorf does not specifically

disclose electronic funds transfer and wherein said collecting step is effecting via the ACH. Muehlberger however, teaches using electronic funds transfer and ACH in col. 3 lines 21-24. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include electronic funds transfer as taught by Muehlberger in order to for the customer to be able to use the telephone card immediately.

Re claim 46: Dorf discloses wherein the telecommunications vendor is a prepaid platform operator. -see col. 5 lines 19-20.

3. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Muehlberger as applied to claim 43 above further in view of Risafi (US Patent No. 6,473,500).

Re claim 44: Dorf and Muehlberger do not specifically disclose said collecting step is carried out in a batch mode on a daily basis. Risafi however, teaches ("In addition to activating a card using these two methods, other functions can be performed on either an individual or a batch basis. The PIN can be changed, the card account can be reloaded, either by the card user or on the card user's behalf, purchases can be made,

and the account can be closed.")-see col. 9 lines 19-23, col. 12 lines 52-67, col. 14 lines 31-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf and Muehlberger to include batch processing as was done by Risafi in order to process many cards at a time.

4. Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Carson (U.S. Patent No. 6,028,920).

Re claim 51: Although Dorf discloses ("The multifunction card system further comprises at least one phone card having a unique identification number encoded on it…")-see col. 3 lines 28-41, Dorf does not specifically disclose the account is a cellular phone account. Carson however, teaches a pre-paid phone card system wherein the telephone service provider associated with the pre-paid telephone card is a wireless telephone service provider. -see col. 16 lines 40-49. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include a pre-paid telephone card to be used with wireless phone service

as taught by Carson in order to provide the customer with a means of pre-paying for wireless telephone service.

5. Claims 56 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Risafi (US Patent No. 6,473,500).

Re claim 56: Although Dorf discloses the user presents the credit card account number in order to purchase goods or services by first making a payment in person at a point of sale to load into the corresponding intermediate account-see col. 4 lines 47-67, Dorf does not specifically disclose purchasing via the Internet. Risafi however, teaches ("Another use for the invention is in electronic commerce as making purchases via the Internet.")-see col. 19 lines 66-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include the using the pre-paid card to make purchases via the Internet as taught by Risafi in order to provide the user with the purchasing convenience provided by the Internet.

Re claim 65: Dorf does not specifically disclose electronically communicating data includes interaction with an IVR system via telecommunications. Risafi however, discloses a pre-paid card system and method using voice recognition.-see

col.7 lines 3-8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Dorf to include a voice recognition system in order to connect to a network.

Response to Arguments

Applicant's arguments filed 3/16/2007 have been fully considered but they are not persuasive.

Regarding the applicant's suggestion that Dorf does not disclose an intermediary account, a payment processor having a database associating an intermediary account number with particular end-user accounts, and crediting an indicia of monetary value to a corresponding intermediary account. The applicant's attention is directed to col. 7 to col. 8 and figs. 1 and 2, wherein Dorf discloses various methods of transferring data from a retailer to a processing hub to an issuer hub. Each step relating an identification number on a card or an account number to another end user account number. For example col. 7 lines 1-32 discloses transaction data being received at the processing hub 103 which recognizes the identification number of the card (end user account number), after verification of the information, the processing hub 103 forwards the card identification number (end user account number), retail store, and POS device information to the issuer hub 104 maintained by

the prepaid phone card issuer. The issuer hub 104 receives the data and activates the record in the phone card database 204 having the same identification number as the card 101 (intermediary account). The value field in the record is then increased by the appropriate purchased amount… The issuer hub 104 then returns an authorization number to the originating POS device 105…Each activation or recharge transaction is recorded by the system 108…Transfer of funds between these parties may then take place by any commercially acceptable means.

Dorf further discloses an electronic gift certificate card in col. 7 lines 35-67 wherein when an activation transaction takes place, the bank would transfer the activation amount form a general account to an account corresponding to the card. Another example can be found in col. 8 lines 62-65 wherein Dorf discloses "When the card 101 is used to make a long distance call, the phone card issuer hub 104 instructs the processing hub 103 to seize the record corresponding to the card 101 in the EGC database 205."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday -Thursday 8:30 am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elda Milef
Examiner
Art Unit 3692

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